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IN THE SUPREME COURT

Supreme Court of the United States

October Term, 1970

No. ...

HUGH R. ANN PRICE, Executrix,

Petitioner

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC., *et al.*,

Respondents

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Supreme Court of the United States

OCTOBER TERM, 1960

No. .....

HELEN RUSSELL PIERCE, Executrix,

Petitioner

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC., *et al.*,

Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Petition Is Without Merit

Question I

The main basis of the petition is an alleged conflict between the decisions of the Courts of Appeals for the First and Fifth Circuits with respect to validity of certain Pierce patents.

There is no conflict between the decisions of the First and Fifth Circuits (printed respectively at pages 13 and 35 of the Petition) such as to justify this Court taking jurisdiction of the case.

The first decision in time (May 12, 1958), was that of the Fifth Circuit, *Pierce v. Aeronautical Communications Equipment, Inc.*, 255 F. 2d 458, which involved an appeal

from a summary judgment that had invalidated the Pierce patents. The Florida District Court in that case had not prepared an opinion but merely entered a judgment to the effect that the Pierce patents were invalid. The Court of Appeals reversed the summary judgment and sent the case back to the lower court for a trial on the merits because the court felt that "plaintiff is entitled to a considered opinion by the district court . . . " (p. 461) and "From the status of the record regarding these patents it does not appear that these patents received the consideration from the court to which they were entitled and the case was not, therefore, ripe for summary judgment" (p. 462). Thereafter, and purely by way of dictum, the court stated that the reasoning in *American Communications Co.* v. *Pierce*, 208 F. 2d 763, and *Pierce* v. *Hewlett-Packard Co.*, 220 F. 2d 631, of the Court of Appeals for the First Circuit "even if valid concerning double patenting, when placed together, do not necessarily preclude plaintiff's success in this case." (p. 462). The Fifth Circuit thought that Pierce should be afforded the opportunity of proving the invalidity of his own expired patent No. 1,789,496, whose validity and infringement were never in issue, in order to overcome the double patenting defense. The erroneousness of the Fifth Circuit's belief that one can attack the validity of his own patent is apparent. The correctness, however, of that belief need not concern us because the fact is that *the Fifth Circuit's decision contains no holding of validity or infringement of any of the Pierce patents.*

Contrast that with the situation in the present case where both the district court and the Court of Appeals filed extensive, carefully prepared opinions holding the Pierce patents invalid for numerous reasons.

We will not go into the reasons which support the decisions in the First Circuit and establish them as being just

and eminently sound in law. Suffice it to say that at least on two prior occasions petitioner unsuccessfully petitioned this Court in an attempt to reverse the main basis of the present decision. *Pierce v. American Communications Co.* (*supra*), cert. denied 347 U. S. 970, 348 U. S. 851; *Pierce v. Hewlett-Packard Co.* (*supra*), cert. denied 350 U. S. 833.

According to the authority relied upon by petitioner (Petition, pp. 2, 3) "Robertson and Kirkham Jurisdiction of the Supreme Court of the United States" by Wolfson and Kurland, 1951, § 354, p. 705, in order for this Court to consider granting certiorari in a patent case there must be a *direct* conflict of decisions between courts of appeals as to validity: As previously discussed, no such conflict exists because while the First Circuit invalidated the patents, the Fifth Circuit merely remanded for trial on the merits.

This case does not present any "real and embarrassing conflict" as to validity of particular claims such as would warrant granting of the petition. *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393, 43 S. Ct. 422, 67 L. Ed. 712. The issues in this case involve only what the Court has termed to be ordinary issues of validity. *Layne & Bowler Corp. v. Western Well Works* (*supra*); *Keller v. Adams-Campbell*, 264 U. S. 314, 319, 44 S. Ct. 356, 68 L. Ed. 705.

Petitioner is here seeking to have the Court review evidence and discuss facts which rest on concurrent findings of two lower courts. The Court has consistently refused to grant a writ in such a situation. *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175, 58 S. Ct. 849, 82 L. Ed. 1273; *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 64 S. Ct. 593, 88 L. Ed. 721.

Stern and Gressman in "Supreme Court Practice", second edition, point out, page 111, that in a growing number

of cases even where there is a "square and irreconcilable" conflict between decisions of courts of appeals the Supreme Court has denied certiorari. This is particularly justified where, as in the present case, all of the patents in suit expired years ago and the issue involved is no longer a live one. See also 66 Harv. L. Rev. 465 (1953).

Question II

Petitioner complains that with respect to three of the Pierce patents summary judgment was improper. Rule 56 of the Federal Rules of Civil Procedure was designed for just such a situation as existed in the present case. The Court of Appeals fully answered petitioner's complaint as follows (Petition, pp. 24, 25):

> "As to these last three patents the plaintiff-appellant contends that summary judgment was improper and that she should have been allowed to present evidence on the issue of their validity at a trial. We are at a loss to perceive what evidence in addition to that before the court below would shed any further light on the issue. Nor do counsel for the plaintiff-appellant in their brief tell us what additional evidence they would like to present. They merely assert in their brief that they have additional evidence, and in their reply brief complain that they would have expatiated further on the question of the validity of these three patents had this court not limited their brief to 160 pages. The simple answer to this is that if they had directed their argument to essential basic issues instead of posing and repetitiously arguing twenty-eight more or less irrelevant separate questions, they would have had ample opportunity to present their argument to this court on these three patents within the space allowed them."

CONCLUSION

For the foregoing reason it is prayed that the petition be denied.

Respectfully submitted,

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JAMES R. BROWNING, Clerk

Supreme Court of the United States

OCTOBER TERM, 1960

No. 422

[redacted]

AMERICAN COMMUNICATIONS COMPANY, INC. [redacted]

[redacted]

PETITIONER'S REPLY BRIEF

[redacted]

Supreme Court of the United States

OCTOBER TERM, 1960

No. 432.

HELEN RUSSELL PIERCE, Executrix,
PETITIONER,

v.

AMERICAN COMMUNICATIONS
COMPANY, INC., ET AL.,
RESPONDENTS.

PETITIONER'S REPLY BRIEF

Question I
(Relating to the Basic Patent 2,133,042)

A

The opening paragraph of respondents' brief proceeds upon the supposition that the petition for certiorari is based *only* upon conflict between the Court of Appeals for the First Circuit and the Court of Appeals for the Fifth Circuit.

The respondents, therefore, appear to agree with petitioner's demonstration (pp. 9, 10 of petition) that the Court of Appeals for the First Circuit is also in conflict with prior decisions of this Supreme Court, as well, whereas a

the decision of the Court of Appeals for the Fifth Circuit, as pointed out in its decision (p. 44 of petition), is in complete harmony with these prior decisions of this Court.

This Court is continually reversing, even summarily, decisions that are inconsistent with its own prior decisions. *United States* v. *Hulley*, 358 U.S. 66, *Rogers* v. *Calumet National Bank of Hammond*, 358 U.S. 331. This applies also to patent cases, *Eastman Kodak Co.* v. *Gray*, 292 U.S. 332, 336.

The respondents are in error, at the bottom of page 3 of their brief, in stating that "Petitioner is here seeking to have the Court review evidence and discuss facts". The petitioner raises purely a question of law. That question is as to whether an inventor may obtain both a patent for a combination (a new particular kind of combined radio transmitting-and-receiving system) and also a basic patent for a new element (the new Pierce oscillator) of that combination, which new element has also wide general use, pp. 5, 6 of petition. (As a matter of fact, the new radio transmitting-and-receiving-system combination required optionally the use of *two* Pierce oscillators, as *two* elements of the combination and not merely one, pp. 6-7 of petition.)

That question has been decided affirmatively by this Court and the Court of Appeals for the Fifth Circuit. The Court of Appeals for the Fifth Circuit has specifically held in connection with the validity of granting patent 2,133,642 (p. 45 of the petition) that

> "If, as appears to be undisputed, the plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to a patent *on it alone*".

in addition to the patent for the combination. The Court of Appeals for the First Circuit, on the other hand, has answered this question in the negative, holding that it was beyond the power of the Commissioner of Patents to grant both patents, under the doctrine of so-called double patenting.

That is the conflict, insofar as the basic patent 2,133,642 is concerned, that is raised by the petition. It is a conflict of law, not of fact.

This Court has many times granted certiorari in patent cases for the sole purpose of deciding pure questions of law; for example, *Mercoid Corporation* v. *Mid-Continent Investment Co.*, 320 U.S. 661, *Precision Instrument Manufacturing Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, and *Scott Paper Co.* v. *Marcalus Manufacturing Co., Inc.*, 326 U.S. 249. In *Fourco Glass Co.* v. *Transmira Products Corp.*, 353 U.S. 222, 224, as another example, the basis for the grant of certiorari, precisely the same as in the present case, was "an asserted conflict with this Court's decision in" another case, "and to resolve a conflict among the circuits" upon a purely legal question.

It is not in patent cases alone that this Court takes jurisdiction for the purpose of resolving questions of law. This Court emphasized "an important question of statutory construction," for example, in *Shapiro* v. *United States*, 335 U.S. 1, 4, and "the importance of the federal questions" in *United Brotherhood of Carpenters and Joiners of America* v. *United States*, 330 U.S. 395, 400.

In *City of New York* v. *Saper*, 336 U.S. 328, 329, this Court granted certiorari to resolve a conflict "of considerable practical importance in the administration of the Bankruptcy Act." The present conflict is of equal importance with respect to the administration of the Patent Laws.

The Patent Office should promptly be informed whether it should continue to grant both combination and element

patents, as previously authorized by this Court and approved by the Court of Appeals for the Fifth Circuit, or whether, on the other hand, it should cease doing so, as required by the decision of the Court of Appeals for the First Circuit.

The importance of this question is made evident by the fact that this controversy itself arose by very reason of the Patent Office, conformably to its practice, refusing to grant a single patent covering both the basic Pierce-oscillator element invention and the particular type of radio transmitting-and-receiving-system combination invention, but insisting that these two inventions must be covered by two separate patents (petition, p. 6).

Thousands of patents granted under this practice, heretofore approved by this Court and the Court of Appeals for the Fifth Circuit, are now in jeopardy under the ruling of the Court of Appeals for the First Circuit.

C

The respondents, as a matter of fact, admit that this case does actually present a conflict of law (not of fact), but argue that it is not a *direct* conflict (italics the respondents').

Mr. Justice Frankfurter and his co-author, Henry M. Hart, Jr., in "The Business of the Supreme Court at the October Term, 1933," 48 Harv. L. Rev. 238, 268, made this same distinction between what they described as "a square conflict" and a conflict that is not quite so "square"; and, in his and Mr. Adrian S. Fisher's corresponding treatment of "The Business of the Supreme Court at the October Terms, 1935 and 1936," 51 Harv. L. Rev. 577, 596, the similar distinction was made between what was there described as "a head-on collision" "between two circuit

courts of appeals" "regarding the validity of a patent" and a collision that is not quite so "head-on".

Contrary to this contention of the defendants, however, Mr. Justice Frankfurter and his co-authors did not say that this Court has ever held that certiorari would be granted *only* in cases of "a square conflict" or *only* in cases of "a head-on collision". They made it plain, indeed, that this Court has continually granted certiorari, when there actually was a conflict, irrespective of whether that conflict was "square" or "head-on", or otherwise. In the Volume 48 article, therefore, Mr. Justice Frankfurter went on to inquire as to "What constitutes a 'conflict'", even though not "square"; and, in the Volume 51 article, he proceeded similarly to examine into "more subtle cases of conflict" where "the existence of a conflict is legitimately debatable", even though not "head-on", but which nevertheless "present precisely the kind of situation for which the Court's discretion is properly invoked". It is only in cases of spurious conflict, such as those based upon counsel's possibly distorted view of the facts of the case, 48 Harv. L. Rev., at the top of p. 273, that the Court does not grant the writ. As Mr. Justice Frankfurter explained further, this Court has always held that "the element of importance lies in the *fact of conflict* rather than the nature of the issue" (italics supplied).

United States v. *Bruno*, 329 U.S. 207, 208, for example, did not present a "direct" conflict. It presented only "an asserted conflict in principle". *Delgadillo* v. *Carmichael*, 332 U.S. 388, 389, and *Glass City Bank* v. *United States*, 326 U.S. 265, 267, presented a "seeming conflict". And *Defense Supplies Corp.* v. *Lawrence Warehouse Co.*, 336 U.S. 631, 633, was concerned with only an "alleged conflict".

This case presents the very situation, therefor, of "a *real* and *embarrassing* conflict of *opinion* and *authority*"

that Mr. Chief Justice Taft referred to in the very case cited on page 3 of the brief of the respondents, *Laguna Bowler Corporation* v. *Western Well Works, Inc.*, 261 U.S. 387, 393.

D

The respondents are entirely wrong in stating, page 2 of their reply brief, that the decision of the Court of Appeals for the Fifth Circuit was "purely by way of dictum".

It is quite true, as stated on page 3 of the brief for the respondents, that the Court of Appeals for the Fifth Circuit "remanded for trial on the merits".

It is decidedly *not* true, however, as the respondents assert further, that the Court of Appeals for the Fifth Circuit "merely" remanded for trial on the merits.

The Court of Appeals for the Fifth Circuit *gave reasons* for so remanding the case and directed the District Court not to follow the law of the Court of Appeals for the First Circuit. Those *reasons*, therefore, were not "merely" or "purely by way of dictum". Those reasons were "direct" holdings that motivated the Court of Appeals for the Fifth Circuit in arriving at its conclusion that the case should be remanded.

Those reasons, furthermore, are in "direct" conflict with the reasons advanced by the Court of Appeals for the First Circuit in holding the basic patent invalid for double patenting.

Not all these reasons will be alluded to here. It will suffice to give just merely three instances of this "*direct*" conflict:

> First, the Court of Appeals for the First Circuit held that Dr. Pierce was not entitled to two patents, one for the radio-transmitting-and-receiving-system

combination invention, and the other for the Pierce oscillator element invention. The Court of Appeals for the Fifth Circuit, on the other hand, however, as appears from the quotation on page 2, *supra*, distinctly held that, in addition to the patent for the combination, Dr. Pierce was entitled also to the patent for the Pierce-oscillator invention "alone".

Second, despite the fact that Dr. Pierce was compelled, against his will, to submit to the grant of two patents, instead of only one, by the orders for division by the Patent Office, the Court of Appeals for the First Circuit held that "we are not bound by such a holding and the patent in issue will not be sustained merely because of a requirement of division ordered by the Patent Office", *Pierce* v. *Hewlett-Packard Company*, 220 F.2d 531, 533 (cited at the top of page 3 of the brief for the respondents). The Court of Appeals for the Fifth Circuit, on the other hand, ruled (petition, p. 45) that Dr. Pierce, "by obeying the Patent Office's order", should not be "denied a portion of the protection to which he is entitled".

Third, the Court of Appeals for the Fifth Circuit ruled further: "Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of *Palmer Pneumatic Tire Co.* v. *Lozier*, 6 Cir., 90 F. 732". That was one of the decisions, however, upon which the Court of Appeals for the First Circuit strongly relied for its holding of "double patenting".

E

There are two answers to the respondents' contention that "the issue involved is no longer a live one", because the patents have expired.

The First Answer

The first answer is that the issue is even more "a live one" now than it was when this Court previously refused certiorari (see the top of p. 3 of respondents' brief and the footnote on p. 7 of the petition). At that time, there was not, as yet, any conflict. At the present time, on the other hand, the same patents are involved in a large number of suits in different circuits (p. 39 of petition).

"The moving consideration for the granting of the writ in these cases is the practical fact that a particular patent or claim thereof is valid in one circuit and invalid in another" (petition, p. 2). For this reason, certiorari is granted, in such cases, pp. 706, 707, even after the patent in suit has expired" (petition, p. 3, footnote).

The Court of Appeals for the First Circuit has referred (petition, p. 25) to "Judge Layton's opinion in *Pierce v. Allen B. DuMont Laboratories, Inc.*, 178 F. Supp. 84 (D.C. Del. 1959)" as "in accord" with its views. The Court of Appeals for the First Circuit did not mention, however, the fact that, upon a previous occasion, the same Judge Layton, in the same District Court for the District of Delaware, agreed, instead, with the Court of Appeals for the Fifth Circuit, 166 F. Supp. 332. It is not known whether the Court of Appeals for the Third Circuit will agree with Judge Layton's later holdings "in accord" with the Court of Appeals for the First Circuit, or with Judge Layton's earlier holdings, "in accord" with the Court of Appeals for the Fifth Circuit.

It is submitted, therefore, that this Court ought to put an end to all this litigation by making a definite ruling as to whether the Court of Appeals for the First Circuit or the Court of Appeals for the Fifth Circuit has correctly interpreted the law as to double patenting, as previously

laid down by this Court. In no other way can this conflict ever be resolved, either at this time or in the future.

The Second Answer

As for the respondents' reference to 66 Harv. L. Rev. 465 (1953), Edward T. Roehner and Sheila M. Roehner, "Certiorari—What Is A Conflict Between Circuits", U. Chi. L. Rev., Vol. 20, p. 656, 1953, disagree with the conclusions in this Harvard Law Review article, pp. 659, 664:

> ". . . the Supreme Court still grants certiorari as of if the conflict, because of amendment of the statutes, lacks vitality for future cases."
>
> • • •
>
> "We believe that the Court grants certiorari as of course in conflicts between the circuits, provided the petition for certiorari clearly frames the head-on collision for the Court to see."

The words "head-on collision", as appears from the opening sentence of the article and the accompanying footnote, were coined to describe "a difference by two circuits regarding the validity of a patent", in the Frankfurter and Fisher article before discussed, 51 Harv. L. Rev. 577, 596.

Question II

(Relating to Patents Nos. 2,133,645, 2,133,646 and 2,133,648)

The only answer that the respondents offer with respect to Question II is the holding of the Court of Appeals for the First Circuit:

"Nor do counsel for the plaintiff-appellant in their brief tell us what additional evidence they would like to present".

The Patent Office did not grant these three additional patents Nos. 2,133,645, 2,133,646 and 2,133,648 until after some years of prosecution, which involved also a number of interferences with other inventors. After the smoke, at last, cleared away, the Patent Office finally granted these three patents to cover inventions relating to complicated electronic devices and circuits that were determined, not only *ex parte* but also *inter partes*, in the interferences, of the Pierce oscillator.

These three patents are presumptively valid and the burden of overthrowing that presumption is "heavy". *Radio Corporation of America* v. *Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 8. *Mumm* v. *Jacob E. Decker & Sons*, 301 U.S. 168, 171. Yet the Court of Appeals for the First Circuit has held that lay judges, as they admit they are (petition, p. 21), unskilled in electronics, are able, at a mere glance at the drawings of these three patents, and without any expert evidence as to what is covered thereby, to decide that the Patent Office was wrong in granting these three patents; since, according to the Court of Appeals for the First Circuit, it is very clear to them that these three patents cover only the same Pierce-oscillator invention that is covered by the basic patent 2,133,642.

As appears from the quotation at the top of this page, the Court of Appeals for the First Circuit has held further that it was the duty of the petitioner to offer evidence as to the scope of the complicated inventions covered by these three patents *in advance of trial*, on penalty of otherwise being sent out of court by summary judgment.

The Court of Appeals for the Fifth Circuit, on the other hand, has held that such summary judgment is improper, and that the petitioner is entitled to her day in court.

It is respectfully submitted that this Court ought to resolve this additional conflict, as well.

Conclusion

For the foregoing reasons and the reasons set forth in the petition, it is prayed that the petition be granted.

Respectfully submitted,

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